

II. REMARKS

Before the amendments made herein, claims 4 to 15 and 23 to 28 were pending. Claims 10 to 22 and 26 to 28 have been canceled herein without prejudice. Accordingly, after the amendments made herein are entered, claims 4 to 9 and 23 to 25 will be pending.

A. Regarding the amendments.

Claim 4 has been amended herein to more clearly indicate that the recited pair of oligonucleotides are capable of directing the recited PCR amplification. The amendment is supported, for example, by column 12, lines 49-62 of the '822 patent.

Applicants respectfully submit that no issue of new matter is raised by the amendments made herein.

B. Regarding the written description rejection.

In paragraph 4 of the Office Action, claims 10 to 15 and 26 to 28 are rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the written description requirement. Specifically, the Action objects to the recited term "kit." Applicants respectfully traverse the rejection.

To promote prosecution of the subject application and to promote issuance of the subject claims, Applicants have canceled claims 10 to 15 and 26 to 28 without prejudice. Accordingly, Applicants respectfully request that this rejection be withdrawn.

C. Regarding the indefiniteness rejection.

In paragraph 6 of the Office Action, claims 4 to 15 and 23 to 28 are rejected under 35 U.S.C. § 112, second paragraph, as allegedly indefinite. More specifically, the Action finds the recited phrase “being capable of directing” to be unclear. Applicants respectfully traverse this rejection.

The Action suggests that claims 4 and 10 instead recite the phrase “said oligonucleotides capable of directing.” To promote prosecution of the subject application and to promote issuance of the subject claims, Applicants have so amended claim 4 (and all claims dependent thereon). Claim 10, and all claims dependent thereon, has been canceled herein without prejudice. Accordingly, withdrawal of this rejection is respectfully requested.

D. Regarding the prior art rejections.

The Action has made one anticipation rejection and three obviousness rejection based on deeming the priority date of the subject application as the filing date of the subject application (October 2, 2003). The Action makes this determination because it interprets the rejected claims in a way as to allegedly not be supported by the ‘822 patent. Applicants respectfully traverse these rejections.

In response, the referred to claim interpretation alleged not to be supported by the ‘822 patent (the inclusion of fragments that do not encode heparanase) can no longer be made, as the rejected claims have been canceled herein without prejudice. Accordingly, Applicants respectfully submit that the priority date of the subject application (and the remaining subject claims) is no later than May 1, 1998.

The first anticipation rejection (paragraph 10 of the Action) is based on a reference published August 1, 2002. Because the priority date of the subject application and remaining subject claims predate this reference, this rejection must fail.

The first obviousness rejection (paragraph 11 of the Action) is based, in part, on the same reference discussed above. Because the priority date of the subject application predates this reference, this rejection must also fail.

The second obviousness rejection (paragraph 12 of the Action) is based, in part on a reference published March 11, 1999. Because the priority date of the subject application predates this reference, this rejection must also fail.

The third obviousness rejection (paragraph 13 of the Action) is based, in part, on a reference published November 11, 1999. Because the priority date of the subject application predates this reference, this rejection must fail.

Accordingly, Applicants respectfully request that all the prior art rejections be withdrawn.

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III. CONCLUSION

All of the issues raised in the Office Action have been addressed and are believed to have been overcome. Accordingly, it is respectfully submitted that all the claims under examination in the subject application are allowable. Therefore Applicants respectfully request a Notice of Allowance to this effect.

Respectfully submitted,



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Encls.

Petition and Fee for Extension of One (1)month time